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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,581	11/13/2000	Ernesto Marelli	33885/GM/lp	5196

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EXAMINER

TOOMER, CEPHIA D

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 02/14/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

FD-3

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 11 and 12, the language "particularly..." is indefinite. It is not clear if the language that follows is a limitation of the claims.

In claim 3, "monoleate" should read -- monooleate --.

In claim 4, the language "chosen from the group constituted by" should be deleted and replaced by conventional claim language, such as --selected from the group consisting of--.

Claim 12 is rejected because the claim recites that claim 9 is a method. Also, the term "obtainable" is indefinite.

In claim 13, the terms "capable of " is indefinite. This is not positive claim language.

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It is noted in the specification that applicant is incorporating subject matter from a co-pending US Application. Applicant is requested to submit the serial number for this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lepain (US 4, 477,258).

Lepain teaches a diesel fuel composition comprising 97-90 vol% of a mixture of a major amount of diesel fuel and a minor amount of at least 5 volume % ethanol/and or/methanol. The composition is an emulsion and contains 3-10 vol % of an emulsifying blend of sorbitan monooleate and an ethoxylated surfactant (see abstract; col. 1, lines 45-52). The ethoxylated surfactant may be ethoxylated nonylphenol with 8-50 EO or ethoxylated fatty alcohols with 6-50 EO (see col. 2, lines 50-58; Example 1(D).) The volume percent of water is from 43 to 74 percent of the aqueous alcohol solution (see col. 1, lines 53-68). This encompasses the water proportions. Lepain teaches that the required HLB may be reached by varying the amounts of the emulsifiers.

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Lepain teaching all the material the limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lepain (US 4,477,258).

Lepain fails to teach that his composition contains a biocide agent.

However, the examiner takes Official Notice that biocide agents are conventional in water containing fuels and it would have been obvious to one of ordinary skill in the art to have the agent with the expectation that it would perform its attendant function.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 6, 7, 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boehmke (US 4,295,859).

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Boehmke teaches a gasoline or diesel fuel composition that contains 55-97% fuel, 0.5 – 40% water and emulsifiers (see abstract, col. 1, lines 5-12). The non-ionic emulsifiers (emulsive) are oxyethylated products (2-5 mols) of alcohols with 8-22 C atoms, such as cetyl stearyl alcohol or nonyl phenol + 6 mols of ethylene oxide (see Examples 9 and 10). The emulsifiers such as fatty acid monoglyceride are also present in the composition (see col. 3, lines 1-13).

Boehmke teaching all the material limitations of the claims, anticipates the claims.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boehmke (US 4,295,859).

Boehmke fails to teach that his composition contains a biocide agent. However, the examiner takes official notice that the use of biocide agents in water containing fuels is conventional.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

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published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 9 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Haupais (US 6,068,670).

Haupais teaches an emulsified diesel fuel composition comprising at least 5% water, sorbitan monooleate, and nonylphenol ethoxylate (see abstract; col. 6, lines 18-45; col. 7, lines 10-25; col. 7, lines 46-57). Haupais outlines the proportions of the component as follows: fuel – 50 – 99%; water 0.1 – 50 %, emulsifying system 0.5 – 5% and additives (biocide) 0.01 – 5% (see col. 8, lines 32-53).

Accordingly, Haupais teaching all the material limitations of the claims, anticipates the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nixon (US 3,615,290).

Nixon teaches a diesel fuel composition comprising about 1.5 wt% water, 0.001 to 1 wt % corrosion inhibitor (salt of PIBSA) and 0.25 – 10% emulsifier (see abstract; col .3, lines 7-20; col. 4, lines 24-36 and claim 1). Nixon teaches that of combination of two or more emulsifiers obtains the best results. The HLB of the emulsifiers is from 11-16 and the emulsifiers include C₅-C₁₂ alkylphenylpolyethoxy alcohols (5-15 ethoxy

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groups), ethoxylated fatty alcohols and sorbitan monoleate (see col. 5, lines 35-75; col. 6, lines 1-33).

Accordingly, Nixon teaching all the material limitations of the claims, anticipates the claims.

The prior art made of record and not relied upon is cited for teaching the general state of the emulsified fuel art.

Any inquiry concerning this communication should be directed to Cephia D. Toomer at telephone number (703) 308-2509.


Cephia D. Toomer
Patent Examiner-1714

09/709581\3/om

January 16, 2002